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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,145	12/31/2003	Peqi Jiang	ESSR:076US	7917
32425 7590 09/20/2007 FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701			EXAMINER WOLLSCHLAGER, JEFFREY MICHAEL	
			ART UNIT 1732	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/750,145

Applicant(s)

JIANG ET AL.

Examiner

Jeff Wollschlager

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27, 29-34 and 36-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27, 29-34 and 36-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's amendment to the claims filed June 5, 2007 has been entered. Claims 1, 10, 14, 25, 27, 34, 36 and 43 are currently amended. Claim 44 is new. Claims 28 and 35 have been canceled.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14, 17-27, 29-34 and 36-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 1 and 36, the limiting effect of the recitation "fined but unpolished" remains unclear. The examiner does note the part of the instant specification cited in the REMARKS filed June 5, 2007. However, it remains unclear at what degree of roughness/smoothness the instant claims intend be considered "fined but unpolished". The demarcation between "ground", "fined" and "polished" is unclear. Further, the examiner notes that claims 15 and 16 provide values for parameter Rq and that claim 1 is, by definition, broader than these dependent claim recitations. Accordingly, the metes and bounds of claims 1 and 36 remain unclear.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 13, 17-20, 26-27, 30, 32, 34, 36, 37 and 44 are rejected under 35

U.S.C. 102(b) as being anticipated by Gupta et al. (U.S. Patent 5,512,371; issued April 30, 1996).

Regarding claims 1, 36 and 44, Gupta et al. teach a process for transferring a coating onto a surface of a prescription/ophthalmic lens preform comprising: providing a finished or semi-finished optical preform having at least one geometrically defined surface (col. 3, lines 25-36, element (11)); providing a mold part (13) having an internal surface and an external surface; depositing a liquid curable moving coating composition of optical resin between the mold and the preform; moving relative to each other the preform and the mold; necessarily applying sufficient pressure to spread the liquid curable coating resin; curing the resin; withdrawing the mold and recovering the coated article (col. 4, lines 26-60; col. 5, lines 13-20 and 28-45 and 60-64; col. 6, lines 57-60).

As to claim 2, Gupta et al. teach the liquid is cured under pressure (col. 5, lines 28-45).

As to claim 3, Gupta et al. teach the mold part is glass or metal (col. 3, lines 11-24).

As to claims 4 and 13, Gupta et al. teach the mold is made of plastic (col. 3, lines 11-14).

It is noted that plastic is more flexible than glass or metal.

As to claim 5, Gupta et al. teach the liquid is UV curable (col. 5, lines 60-66).

As to claims 6 and 7, Gupta et al. teach the mold part is uv-transparent plastic (col. 3, lines 11-14).

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As to claims 17-20 and 37, the finished and/or semi-finished preform disclosed by Gupta et al. intrinsically has the same surface roughness and is made of polycarbonate (col. 3, lines 25-38).

As to claim 26, Gupta et al. teach the resin provides anti-scratch properties (col. 3, lines 1-9).

As to claims 27 and 34, Gupta et al. teach the main face of the preform may be the back face of the preform (col. 4, lines 35-41).

As to claims 30 and 32, Gupta et al. teach the optical article is a lens (col. 3, lines 25-38) and that the lens may be colored or coated with photochromatic materials (col. 4, lines 21-25).

Claims 1-27, 30, 32-34, 36, 37 and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Jiang et al. (U.S. Patent 6,562,466; issued May 13, 2003; filed July 2, 2001).

Regarding claims 1, 36 and 44, Jiang et al. teach a process for transferring a coating onto a surface of a lens blank comprising: providing a lens blank having at least one geometrically defined surface wherein the definition of geometrically defined provided in the specification includes a surface that is fined but unpolished; providing a support/mold part having an internal surface bearing a coating and an external surface; depositing on said geometrically defined surface or said coating a premeasured amount of curable glue (also a liquid curable coating composition); moving relative to each other the lens blank and the support; applying a sufficient pressure so that the thickness of a final glue layer is less than 100 micrometers; curing the glue; withdrawing the support/mold part and recovering the lens blank (claim 1; col. 2, line 47- col. 3, line 28).

As to claim 2, the liquid curable composition is cured under pressure (col. 3, lines 42-44).

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As to claims 3, 4, 6, and 11-14 Jiang et al. employ rigid or flexible mold parts such as polycarbonate with a thickness of 0.3 to 1 mm and that can be in the form of a flexible membrane (col. 3, lines 44-46 and line 58-col. 4, lines 11)

As to claims 5 and 7, Jiang et al. employ uv transparent polycarbonate and a uv curable liquid coating glue (col. 3, lines 58- col. 4, lines 11; col. 6, lines 36-50).

As to claim 8, Jiang et al. teach the flexible part has a shorter radius of curvature than the surface of the blank to be coated (col. 4, lines 17-19).

As to claims 9 and 10, Jiang et al. teach a preferable pressure range of 5 to 20 psi (col. 3, lines 47-48).

As to claims 15-20 and 37, Jiang et al. teach the surface roughness of the optical article is from  $10^{-3}$  micrometers to 1 micrometer (col. 3, lines 29-32) and that the optical article may be polycarbonate (col. 5, lines 1-10).

As to claims 21-24, Jiang et al. teach the total thickness of the coating to be transferred is preferred to be 10 micrometers or less (col. 4, lines 53-55) and that the thickness of the glue is usually 1 to 30 micrometers (col. 5, lines 1-3).

As to claim 25, Jiang et al. disclose the same claimed materials and the same claimed process. As such the refractive index difference between the lens blank and the cured coating are the same.

As to claim 26, Jiang et al. disclose employment of anti-abrasive coatings, tinted coatings, and anti-reflective coatings as conventional (col. 1, lines 15-22; col. 4, lines 45-53).

As to claims 27 and 34, Jiang et al. teach the main face of the lens blank is the back face of the lens blank (col. 11, lines 53-57).

As to claims 30 and 32, Jiang et al. disclose the article as a lens blank (col. 2, lines 54-55).

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As to claim 33, Jiang et al. disclose a glass mold (col. 7, lines 1-3).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jiang et al. (U.S. Patent 6,562,466; issued May 13, 2003; filed July 2, 2001), as applied to claim 1-27, 30, 32-34, 36 and 37 above, further in view of Degand et al. (U.S. 6,489,028).

As to claim 29, Jiang et al. teach the method of claim 1 as discussed in the 102(e) rejection above, and further disclose anti-reflective coatings as conventional, but do not expressly teach applying anti-reflective coatings onto the cured coating. However, Degand et al. disclose that it is known to apply the anti-reflective coating to the cured surface of the lens (col. 6, lines 1-6).

Therefore it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the claimed invention to employ a known sequence of steps for applying the anti-

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reflective coating to the surface of the cured lens as taught by Degand et al. while practicing the method of Jiang et al. for the purpose as taught by Degand et al. of providing a lens that has excellent abrasion resistance while also having anti-reflective properties (col. 5, lines 38-col. 6, lines 9).

Claims 31 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jiang et al. (U.S. Patent 6,562,466; issued May 13, 2003; filed July 2, 2001), as applied to claim 1-27, 30, 32-34, 36 and 37 above, further in view of Brytsche et al. (U.S. 5,753,301).

As to claims 31 and 38, Jiang et al. teach the method of claim 1 as discussed above, but do not expressly disclose the method is employed to coat a transparent lens mold. However, Brytsche et al. disclose that methods of coating lens, lens blanks and lens molds are known to be interchangeable and equivalent (Abstract).

Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art to utilize the method disclosed by Jiang et al. to coat a lens mold since Brytsche et al. disclose that lens molds, lens, and lens blanks may be coated through equivalent means. One having ordinary skill would have been motivated to maximize the applications of Jiang et al.'s method as suggested by the disclosure of the art-recognized equivalence of the materials.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jiang et al. (U.S. Patent 6,562,466; issued May 13, 2003; filed July 2, 2001) in view of Brytsche et al. (U.S. 5,753,301), as applied to claim 38 above, and further in view of Friske et al. (U.S. Patent 5,254,000).

As to claim 39, Friske et al. disclose that lens molds made of polypropylene are conventional and preferred in the art (col. 2, lines 3-11).



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Therefore it would have been *prima facie* obvious to employ conventional and preferred lens mold materials as taught by Friske et al. for the purpose of providing a lens mold that does not mold or distort when the lens is cured (col. 2, lines 3-11).

Claims 40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jiang et al. (U.S. Patent 6,562,466; issued May 13, 2003; filed July 2, 2001), as applied to claim 1-27, 30, 32-34, 36 and 37 above, further in view of Li et al. (U.S. 6,565,776).

As to claims 40 and 42, Jiang et al. teach the method of claims 1 and 36 as discussed above, but do not teach the mold part is precoated with a release or protective coating. However, Li et al. teach that it is known to provide lens mold parts with a protective coating (Abstract).

Therefore it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the claimed invention to provide a protective layer to the mold part disclosed by Jiang et al. as suggested by Li et al. for the purpose, as taught by Li et al., of producing a mold part with greater dimensional stability (Abstract).

Claims 41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jiang et al. (U.S. Patent 6,562,466; issued May 13, 2003; filed July 2, 2001), as applied to claim 1-27, 30, 32-34, 36 and 37 above, further in view of Keller et al. (U.S. 6,491,851).

As to claims 41 and 43, Jiang et al. teach the method of claims 1 and 36 as discussed above but do not disclose a mold part having a microstructure or a pattern to be duplicated in the lens blank. However, Keller et al. disclose a mold part having a microstructure or a pattern to be duplicated in the lens blank (Abstract).

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Therefore it would have been *prima facie* obvious to one having ordinary skill in the art to employ a mold part with a microstructured surface as disclosed by Keller et al. to produce a lens with improved anti-glare properties, as suggested by Keller et al. (Abstract).

Claims 9, 10, 12, 14, and 29 are rejected under 35 U.S.C. 103(a) as being obvious over Gupta et al. (U.S. Patent 5,512,371; issued April 30, 1996).

As to claim 9 and 10, Gupta et al. do not disclose the claimed pressure. However, the applied pressure would impact the application of the coating, the thickness of the coating, and if not properly controlled, would result in a damaged or broken lens preform. As such, the applied pressure would have been readily optimized as is routinely practiced in the art.

As to claims 12 and 14, Gupta et al. do not disclose the mold thickness or whether the plastic mold comprises polycarbonate or PMMA. However, one having ordinary skill would have been motivated to employ conventional mold parts and dimensions as suggested by Gupta (col. 3, lines 22-24).

As to claim 29, anti-reflective coatings are conventional in the art.

### ***Response to Arguments***

Applicant's arguments filed June 5, 2007 regarding the ODP rejections have been considered, but are moot in view of the amendment to the claims in the instant case and the current status of the claims in the applied references in the provisional ODP rejections (e.g. abandoned, claims amended). The rejections have been withdrawn.

Applicant's other arguments filed June 5, 2007 have been fully considered, but they are not persuasive.

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Applicant's arguments appear to be on the following grounds:

1. The term "fined but unpolished" is not indefinite.
2. Gupta teaches "semi-finished" lenses may be employed. However, this is not the same as "fined but unpolished".
3. Jiang et al. do not teach forming a final product with only a one layered coating.

The arguments are not persuasive for the following reason:

1. As set forth above in the 35 USC 112 second paragraph rejection, the limiting effect of the term "fined but unpolished" remains unclear in claims 1-14, 17-27, 29-34, and 36-44. The examiner notes that the 112 rejection over claims 15 and 16 regarding the term "fined but unpolished" has been withdrawn as these claims provide a range of roughness/smoothness which clearly and distinctly defines the scope of the term "fined but unpolished".

2. Applicant argues that "semi-finished" does not mean "fined but unpolished". However, the examiner notes that attorney arguments cannot take the place of evidence in the record and further notes that there is no convincing evidence in the record to support the conclusory statement that the term is defined as argued in the art. The examiner maintains that "semi-finished" is reasonably understood to meet the scope of the claimed limitation, particularly in view of the indefinite status of the term "fined but unpolished" in the claims. Further, the examiner notes that the rejection of claims 15 and 16 over Gupta et al. has been withdrawn. Further still, regarding claim 1, the examiner notes that since Gupta et al. perform the same claimed steps with the same claimed materials, one would intrinsically realize the same claimed effects and physical properties in the final product (i.e. free of visible fining lines).

3. While the examiner agrees that the ODP rejection over Jiang et al. has been overcome by the amendment to the claims, it is the examiner's position that Jiang et al. still teach and disclose the subject matter claimed. For example, Jiang et al. disclose, "It can also

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be the anti-abrasion layer, in particular when no primer layer is to be transferred to the blank." (col. 3, lines 10-12). In the context of the paragraph "It" refers to the "curable glue" (col. 3, lines 5-12). Further, Jiang et al. disclose that the "coating may comprise any coating layer or stack of coating layers classically used in the optical field, such as an anti-reflective coating layer, an anti-abrasion coating layer, an impact resistant coating layer...or a stack of two or more of these coating layers" (col. 4, lines 43-52). As such, Jiang et al. disclose that the glue layer can be employed as the anti-abrasion coating layer and then suggest that one coating layer, even specifically mentioning an anti-abrasion coating layer by name, may be used alone or in a stack of coating layers. As such, the full disclosure of Jiang et al. includes the disclosure of a one-layer coating, for example, a layer of curable glue functioning as the single anti-abrasion coating layer. Accordingly, Jiang et al. still meet the claim.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Wollschlager whose telephone number is 571-272-8937. The examiner can normally be reached on Monday - Thursday 7:00 - 4:45, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JW

Jeff Wollschlager  
Examiner  
Art Unit 1732

  
CHRISTINA JOHNSON  
SUPERVISORY PATENT EXAMINER

September 14, 2007